



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/584,628

06/26/2006

Naoyuki Onoda

10993.0272

9660

22852

7590

01/20/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ROBINSON, CHANCEITY N

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

01/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,628	Applicant(s) ONODA ET AL.	
	Examiner CHANCEITY N. ROBINSON	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/30/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicant's request for reconsideration filed on October 27, 2009 was received. Claims 1, 3 and 6 have been amended. Claims 17-19 have been added. Claims 10-12 and 14-16 have been withdrawn. Claims 15 and 16 have been withdrawn and currently amended. Claim 13 has been canceled.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action issued on July 30, 2009.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 3-9 recites the limitation "modifying groups" in claims 3 and 7. However, there are no modifying groups recited in the independent claim 1. Independent claim 1 only recites a "reactive functional group". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required. In order to further prosecution, for purposes of examination, the examiner has considered the reactive functional group as the same as the modifying group.

Claim Rejections - 35 USC § 102

5. Claims 1-6, 8-9 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida (US 6,403,284 B1).

Regarding claims 1-6, 8-9 and 17-19, Yoshida discloses a method for producing a water-developable photopolymer plate for letterpress printing (photosensitive resin printing plate; col. 1, lines 13-20) comprising an exposure step, a development step and post-exposure step (col. 4, lines 54-67). Yoshida discloses the photopolymer plate is brought into contact and irradiated

Art Unit: 1795

with a liquid (developer) comprising a modified silicone compound and/or a modified fluorine compound during or after exposure step (the hydrogen-abstracting agent-impregnation step and tackiness-removing exposure step of col. 17, line 20- col. 18, line 67 and claims 1-9). The photopolymer comprises a binder polymer comprising a polar group-containing polymer and a hydrophobic polymer (prepolymers); an ethylenically unsaturated compound; and a photopolymerization initiator (col. 5, lines 7-11 and examples). The surface treating solution improves the handling the treating solution and enhanced productivity (col. 4, lines 26-46). The surface treating solution comprises a hydrogen abstracting agent whom can be the organic fluorine-carbonyl compounds modified by phenyl, hydroxy or epoxy or carboxyl groups (col. 5, lines 33- col. 7, line 67).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1795

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1, 3-6, 8-9 and 17-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji (US 2002/0182543 A1) in view of Yoshida (US 6,403,284 B1).

Fuji discloses a method (abstract) for producing a water-developable photopolymer plate for letterpress printing plate [0001] comprising a exposure step [0009 and 0076], a development step [0012, 0046-0047 and 0060-0062] and post-exposure step [0072 and 0081]. The method further comprises a contact step during or after the exposure step and irradiation step with actinic light during or after the contact step [0009, 0018 and examples 1 and 2].

Fuji does not explicitly disclose the contact step brings the photopolymer plate into contact with a liquid comprising a silicone compound and/or fluorine compound modified with a reactive functional group. Fuji disclose the contact step includes spraying the developing liquid on the photopolymer plate [0009 and examples]. The developing liquid can be convention developing liquid containing a silicone mixture [0076] or an aqueous developing liquid comprises of water, surfactant, organic carbonyl compound, hydrogen abstracting agent and other components that do not impair the effect of the invention [0045-0059]. The purpose of Fuji is the development of a method for developing a photosensitive letterpress plate that reduce the coast to treat worn out developing liquid and to give sharp printing results [0008-0009]. However, Yoshida discloses a surface-treating solution for a photosensitive resin printing plate (abstract). The surface treating solution improves the handling the treating solution and enhanced productivity (col. 4, lines 26-46). The surface treating solution comprises a hydrogen abstracting agent whom can be the organic fluorine-carbonyl compounds modified by phenyl, hydroxy or

Art Unit: 1795

epoxy or carboxyl groups (col. 5, lines 33- col. 7, line 67). Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to include/modify the developing solution of Fuji to comprise the hydrogen abstracting agent disclosed by Yoshida in view of enhancing productivity and reducing cost.

Response to Arguments

9. Applicant's arguments with respect to claims 1-9 and 17-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANCEITY N. ROBINSON whose telephone number is

Art Unit: 1795

(571)270-3786. The examiner can normally be reached on Monday to Friday (with every other Friday off): 9:00 am-6:00 pm eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chanceity N Robinson/
Examiner, Art Unit 1795

/Cynthia H Kelly/

Supervisory Patent Examiner, Art Unit 1795